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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/000,325 | 12/04/2001 | Michael S.H. Chu | -06530.0285-00000. | 9761 |

22852 7590 12/13/2005

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| EXAMINER |
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THALER, MICHAEL H

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| ART UNIT | PAPER NUMBER |
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3731

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/000,325

Applicant(s)

CHU, MICHAEL S.H.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39,61-107,109,112,115 and 118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39,61-107,109,112,115 and 118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Claims 1-4, 7-10, 14-19-26, 30-34, 38, 39, 61-64, 67-70, 74-90, 94-98, 102-107, 109, 112, 115 and 118 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamamoto et al. (6,059,719). Yamamoto et al., in figure 13, for example, disclose elongate member (the combination of (A) the central wire between members 132-134 and member 8 and (B) wire 22 which are secured together at 8a and 24 to form a single member) for insertion into a channel 20 of the endoscope 2, distal assembly 6B having an open configuration and a closed configuration with a profile larger than a diameter of the channel 20 of the endoscope 2 wherein the distal assembly includes a tube 8b, 8c and an end effector 9b (col. 13, lines 33-35). Alternatively, it would have been obvious that the combination of the wires cited above form a single member since they are secured together at 8a and 24 to form a single entity. As to claim 3, Yamamoto et al. disclose a stop at 17b. As to claim 7, Yamamoto et al. disclose attachment cup 70. As to claim 8, the activation shaft is inherently capable of rotating the distal assembly when the activation shaft is rotated. As to claim 9, the distal end of the activation shaft is bent when it is in a curved path in the body. As to claim 10, the distal assembly is inherently capable of obtaining and storing multiple small samples. As to claim

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15, Yamamoto et al. disclose ring 24. As to 20, 21, 80, 81, 83, 84 and 105-107, the proximal portion of each member 132-134 is a spring since it is elastic and biased outwardly while the distal portions of members 132-134 are considered to be the claimed jaw members.

Claims 5, 6, 11-13, 27-29, 35-37, 65-66, 71-73, 91-93 and 99-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (6,059,719) in view of Townsend et al. (6,066,102). As to claims 5, 6, 27-29, 65, 66 and 91-93, Yamamoto et al. fail to disclose the details of the handle with the slide. However, it is old and well known in this art to so construct handles for reliably and smoothly activating surgical end effectors. For example, Townsend et al. discloses casing (the frame on which handle 42 slides), slide 46, cap (at the proximal end of the frame), knob 44, 42 and a groove (the groove that 44 slides in). It would have been obvious to so construct the Yamamoto et al. handle so that it too would have this advantage. As to claims 11-13, 35-37 and 71-73, Yamamoto et al. fail to disclose the details of the distal assembly and elongate member. However, it is old and well known in this art to so construct a 1) distal assembly and 2) an elongate member in order to obtain the advantage of 1) performing specific operations and 2) for reliably and smoothly activating surgical

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end effectors. For example, Townsend et al. discloses needle 718 and a lumen 28 to receive a medical device (col. 6, lines 44-55). It would have been obvious to so construct the Yamamoto et al. distal assembly and elongate member so that it too would have this advantage.

Applicant's arguments filed Oct. 13, 2005 have been fully considered but they are not persuasive for the reasons set forth above. Note that page 3, lines 8-9 of the Office Action mailed July 26, 2005 referred to figure 13 of Yamamoto et al.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

mht
12/9/05



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731